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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,883	02/04/2004	Peter Tews	COH-15303	3749
40854	7590	05/12/2006		
RANKIN, HILL, PORTER & CLARK LLP 4080 ERIE STREET WILLOUGHBY, OH 44094-7836				
EXAMINER KASTLER, SCOTT R				
ART UNIT			PAPER NUMBER	

1742

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,883

Applicant(s)

TEWS, PETER

Examiner

Scott Kastler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-21 and 27-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-21 and 27-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/06 7/28/05</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The above claims are indefinite because these claims recite alloys “comprising” various components, while the claim from which they depend (claim 2) recites an alloy “consisting essentially of” various components, rendering the dependent claims (claims 5 and 6) broader, rather than more narrow in scope as required, than the claim (claim 2) from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11, 12, 14-21, 27, 28 and 32-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese'260. Japanese'260 teaches a platinum alloy containing cobalt and copper in the wt% ranges that overlap or closely approximate those recited by the instant claims, see examples C-6 (70%Pt-9.46%Co-9.4%Ni-10%Cu) and example C-17 (79%Pt-11.5%Co-12.4%Cu). The “comprising” and “consisting essentially of” language of the instant claims allow for the addition of Ni in the alloys of Japanese'260 since the term “comprising” allows for

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the addition of other unnamed elements even in major amounts, and the term “consisting essentially of” allows for the addition of elements which do not materially affect the properties of the claimed alloy. Further applicant has defined “consisting essentially of”, at page 8 of the originally filed specification as allowing for the inclusion of property enhancing additives such as hardeners, a deoxidizing agent, grain reducing agent or color variation agent, where Ni is specifically stated as an element which can be added to the alloy of the invention if desired (see page 8, lines 5-8 of the original specification for example). It has been well settled that where the prior art discloses a composition range which overlaps or closely approximates a claimed alloy range, absent any demonstrated new or unexpected result arising therefrom, motivation to modify the prior art alloy to meet the claimed alloy range would have been a modification obvious to one of ordinary skill in the art at the time the invention was made. See MPEP 2144.05. In the instant case, absent any demonstrated new or unexpected results arising therefrom, motivation to employ any of the disclosed equally useful compositions within the broadest useful range disclosed by Japanese’260, including those which would also meet the limitations of the instant claims, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

The limitations dealing with the hardness, tensile strength, elongation and color tone would be expected to be inherently met by the alloys within the range recited by Japanese’260 since the compositional limitations are closely met, and absence any showing to the contrary would reasonable be expected to exhibit the same material properties.

The limitations stating that the alloy is an ornamental article or that the alloy is intended to be employed as an ornamental article does not fairly further distinguish the instant claims

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since any article could be considered “ornamental” and further, the intended use of an article cannot be relied upon alone to fairly further distinguish claims to the article itself. See MPEP 2114 and 2115.

The methods of making alloys by blending, melting and casting as recited by one or more of the above claims is conventional and a standard technique of making alloys; and hence would have been expected and obvious to incorporate in the making of the Japanese’260 alloys.

Claims 9, 10, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese’260 as applied to claims 1 and 2 above, in view of Japanese’641. As applied to claims 1 and 2 above, Japanese’260 shows all aspects of the above claims except the additional inclusion of In or Ga in the alloy. It is however, well known in the art as evident by the English abstract of Japanese’641 that these elements are added to Pt alloys to further enhance strength and hardness. Since strength and hardness would also be desirable properties sought by Japanese’260, then it would have been a modification obvious to one of ordinary skill in the art at the time the invention was made to additionally include these additions as taught by Japanese’641 in the alloy of Japanese’260 in order to improve hardness and strength where desired.

Claims 2, 5, 6, 27- 37 and 40-49 rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese’641 or Japanese’032. Each of Japanese’641 and Japanese’032, in their English language abstracts for example, teach a platinum alloy with constituents whose wt% ranges overlap or closely approximate those recited by the above claims, such similarities establishes a

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prima facie case of obviousness because it would have been obvious to one of ordinary skill in the art at the time the invention was made to select alloy ranges from the broader disclosure of the prior art, where the prior art discloses the same utility for the alloy (ornamental and decorative articles), see MPEP 2144.05. It should be noted that Japanese'641 discloses a lower limit of 80% Pt where the present invention discloses an upper limit of 79.5% Pt. However, since the applicant has not yet demonstrated any new and unexpected result arising from the use of a Pt range of 79.5% when compared to a Pt range of 80%, then a composition with slightly more Pt would depict a mere difference in the proportion of an element without any attendant unexpected results.

Claims 1-8, 11, 12, 14-21 and 27-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostermann et al. Ostermann et al teaches a platinum alloy for use in the production of ornamental or decorative articles (watch casements for example) including platinum, cobalt and copper in ranges which overlap or closely approximate the disclosed alloy ranges (see claim 2 of Ostermann et al for example). The “comprising” and “consisting essentially of” language of the instant claims allow for the addition of the extra elements in the alloys of Ostermann et al since the term “comprising” allows for the addition of other unnamed elements even in major amounts, and the term “consisting essentially of” allows for the addition of elements which do not materially affect the properties of the claimed alloy. Further, applicant has defined “consisting essentially of”, at page 8 of the originally filed specification as allowing for the inclusion of property enhancing additives such as hardeners, a deoxidizing agent, grain reducing agent or color variation agent. It has been well settled that where the prior art discloses

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a composition range which overlaps or closely approximates a claimed alloy range, absent any demonstrated new or unexpected result arising therefrom, motivation to modify the prior art alloy to meet the claimed alloy range would have been a modification obvious to one of ordinary skill in the art at the time the invention was made. See MPEP 2144.05. In the instant case, absent any demonstrated new or unexpected results arising therefrom, motivation to employ any of the disclosed equally useful compositions within the broadest useful range disclosed by Ostermann et al, including those which would also meet the limitations of the instant claims, would have been a modification obvious to one of ordinary skill in the art at the time the invention was made.

The limitations dealing with the hardness, tensile strength, elongation and color tone would be expected to be inherently met by the alloys within the ranges recited by Ostermann et al since the compositional limitations are closely met, and absence any showing to the contrary would reasonable be expected to exhibit the same material properties.

Response to Arguments

Applicant's arguments filed on 2/8/2006 have been fully considered but they are not persuasive. Applicant's argument that Japanese'260 (US'971) discloses an alloy for use on a powder material rather than as a decorative article or ornament is not persuasive at least because as stated above, any article could be considered ornamental or decorative.

Applicant's further argument that the disclosed alloys of prior art include more than 3 elements and therefore does not meet the "consisting essentially of" limitations of some of the instant claims is not persuasive because as stated above the "comprising" and "consisting

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essentially of” language of the instant claims allow for the addition of the extra elements in the alloys of the applied prior art since the term “comprising” allows for the addition of other unnamed elements even in major amounts, and the term “consisting essentially of” allows for the addition of elements which do not materially affect the properties of the claimed alloy.

Applicant’s further argument that the applied prior art alloys do not exhibit the instantly recited material properties is not persuasive because as stated above, since the alloys of the applied prior art are substantially the same as that claimed, then the material properties would be reasonably expected to inherently be the same. Applicant has not yet presented any showing, in proper declarative form, that the material properties of the prior art alloys would be materially different than the instantly claimed material properties.

New rejections based upon newly discovered Ostermann et al have also been advanced, as stated above.

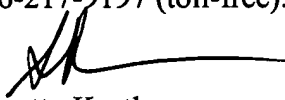
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Kastler whose telephone number is (571) 272-1243. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott Kastler
Primary Examiner
Art Unit 1742

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